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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,071	06/27/2002	Alf Hammes	1999DE507	7262

25255 7590 04/16/2004  
CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
CHARLOTTE, NC 28205

EXAMINER

WHITE, EVERETT NMN

ART UNIT PAPER NUMBER

1623

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,071

Applicant(s)

HAMMES, ALF

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed December 4, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claim 9 has been canceled;
  - (B) Claim 1 has been amended.
  - (C) Comments regarding Office Action have been provided drawn to
    - (i) 103(a) rejection, which has been maintained for the reasons of record;
2. Claims 1-8 and 10-18 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-8, 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Traill et al (US Patent No. 1,943,461) in view of Savage (US Patent No. 3,728,331) for the reasons set forth on pages 2-4 of the Office Action mailed September 4, 2003.
5. Applicant's arguments filed December 4, 2003 have been fully considered but they are not persuasive. Applicants amended Claim 1 to claim the addition of at least one oxidizing agent added to the concentrated aqueous slurry in an amount of between 0.05 and 5% by weight and argues that neither the Traill et al patent nor the Savage patent, alone or in combination, teach or disclose the addition of an oxidizing agent in the prescribed range recited in amended Claim 1. This argument is not persuasive since Example 1 of the Savage patent sets forth treatment of cellulose ether by spraying the cellulose ether with 3 parts of 3% aqueous hydrogen peroxide, wherein said amount of hydrogen peroxide falls within the instantly claimed range set forth in Claim 1 of between 0.05 and 5%, by weight. Accordingly, the rejection of Claims 1-8, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over the Traill et al patent in view of the Savage patent is maintained for the reasons of record.

Art Unit: 1623

6. Claims 12-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Kobayashi et al Patent in view of the Savage patent for the reasons set forth on pages 4 and 5 of the Office Action mailed September 4, 2003.

7. Applicant's arguments filed December 4, 2003 have been fully considered but they are not persuasive. Arguments presented against the rejection of instant Claim 12 over the references for not setting forth an oxidative agent in the range of 0.05% to 5% by weight are not persuasive for the same reasons set forth supra in the rejection of Claims 1-8, 10 and 11 under 35 U.S.C. 103. Applicants further presented arguments against independent Claim 13 by arguing that the Kobayashi et al patent does not set forth a particle size for cellulose ether as instantly claimed and that there is no motivation for the combination of the Savage reference with the Kobayashi et al patent. The Savage reference does set forth cellulose ethers that have particle sizes within the instantly claimed range. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in this art would be motivated to combine the teachings of the Kobayashi EP patent with the teachings of the Savage patent since both patents set forth hydroxypropyl-methyl cellulose and procedures that involve depolymerizing the cellulose ethers, which provides sufficient motivation for combining the references in a rejection of the claims under 35 U.S.C. 103.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 1623

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Accordingly, the rejection of Claims 12-18 under 35 U.S.C. 103(a) as being unpatentable over the Kobayashi et al Patent in view of the Savage patent is maintained for the reasons of record.

### ***Summary***

8. Claims 1-8 and 10-18 are rejected.

### ***Action Made Final***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Examiner's Telephone Number, Fax Number, and Other Information***

10. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (571) 272-0660. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Art Unit: 1623

supervisor, James O. Wilson, can be reach on (571) 272-0661. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



E. White



James O. Wilson  
Supervisory Primary Examiner  
**Technology Center 1600**